

ESTTA Tracking number: **ESTTA428438**

Filing date: **09/02/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Miss World Limited
Granted to Date of previous extension	09/07/2011
Address	Pier Road St. Helier Jersey, UNITED KINGDOM

Attorney information	Jeffrey C. Katz Davis & Gilbert LLP 1740 Broadway New York, NY 10019 UNITED STATES jkatz@dglaw.com, phatry@dglaw.com, chinton@dglaw.com, tyendell@dglaw.com, trademarks@dglaw.com Phone:2124684823
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### Applicant Information

Application No	77947644	Publication date	05/10/2011
Opposition Filing Date	09/02/2011	Opposition Period Ends	09/07/2011
Applicant	WALLY BOYKO PRODUCTIONS, INC. P.O. BOX 2490 WHITE CITY, OR 97503 UNITED STATES		

### Goods/Services Affected by Opposition


Class 041. First Use: 1993/06/15 First Use In Commerce: 1993/06/15  
All goods and services in the class are opposed, namely: Providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of physical fitness for women


### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3597038	Application Date	01/03/2007
Registration Date	03/31/2009	Foreign Priority Date	NONE
Word Mark	MS. WORLD		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1999/04/00 First Use In Commerce: 1999/04/00 CHARITABLE FUND RAISING SERVICES


U.S. Registration No.	3587128	Application Date	02/09/2005
Registration Date	03/10/2009	Foreign Priority Date	NONE
Word Mark	MS. WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1999/04/15 First Use In Commerce: 1999/04/15 Entertainment in the nature of beauty pageants, beauty pageant awards shows,spokesmodel talent competitions, and fashion shows		



U.S. Registration No.	3990366	Application Date	01/09/2008
Registration Date	07/05/2011	Foreign Priority Date	NONE
Word Mark	MR WORLD		

Design Mark	
Description of Mark	The mark consists of a globe positioned above the wording "MR WORLD".
Goods/Services	Class 041. First use: First Use: 2010/11/22 First Use In Commerce: 2010/11/22 entertainment services, namely, live shows featuring body appearance competitions and pageants; motion picture film production services; television show production services and videotape production services

U.S. Registration No.	2915546	Application Date	09/20/2002
Registration Date	01/04/2005	Foreign Priority Date	03/25/2002
Word Mark	MW		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: COSMETICS AND NON-MEDICATED TOILETRIES, NAMELY, HAIR CARE PREPARATIONS, ESSENTIAL OILS FOR PERSONAL USE, SKIN SOAPS, PERFUMES AND DENTIFRICES</p> <p>Class 025. First use: Clothing, namely, anklets, anoraks, aprons, ascots, athletic footwear, athletic shoes, athletic uniforms, babushkas, baby bunting, ski boot bags, balloon pants, bandannas, bandeaus, head bands, neck bands, sweat bands, wrist bands, bathing caps, bathing suits, bathing trunks, bathrobes, beach coverups, beachwear, bed jackets, garter belts, money belts, clothing belts, berets, bermuda shorts, ski bibs, bikinis, blazers, bloomers, blouses, blousons, boas, body shapers, body suits, boleros, bonnets, booties, boots, after ski boots, ski boots, bottoms, bow ties, boxer shorts, toe boxes, bras, brassieres, breeches, briefs bustiers, caftans, camisoles, capes, bathing caps, shower caps, caps, cardigans, cassocks, chaps, chemises, clogs, cloth diapers, infant cloth diapers, coats, fur coats, lab coats, leather coats, over coats, rain coats, sport coats, suit coats, top coats, collars, corselets, corsets, halloween costumes, masquerade</p>		

	<p>costumes, coveralls, coverups, cravats, creepers, cuffs, culottes, cummerbunds, dickies, dresses, dressing gowns, dungarees, dusters, ear muffs, espadrilles, evening gowns, fishing vests, fishing waders, flight suits, footwear, foul weather gear, foundation garments, frocks, fur jackets, fur stoles, gaberdines, gaiters, galoshes, gauchos, girdles, gloves, ski gloves, golf shirts, golf shoes, gowns, night gowns, wedding gowns, greatcoats, gym shorts, gym suits, halter tops, hats, head wear, heel inserts, heels, hoods, hosiery, housecoats, infantwear, inner soles, insoles, jackets, leather jackets, wind resistant jackets, jeans, jerseys, jodhpurs, jogging suits, jumpers, jumpsuits, kerchiefs, kilts, kimonos, knee highs, knickers, knit shirts, leg warmers, leggings, leotards, lingerie, loungewear, maillots, mantillas, mantles, masquerade costumes and masks sold in connection therewith, miniskirts, mittens, moccasins, mufflers, muffs, mukluks, muu muus, neckerchiefs; neckties, neckwear, negligees, night shirts, overalls, overshoes, shoulder pads, pajamas, pantaloons, panties, pants, ski pants, snow pants, sweat pants, tap pants, pantsuits, pantyhose, pareu, parkas, pedal pushers, peignoirs, petticoats, pinafores, play suits, pocket squares, polo shirts, ponchos, pullovers, quilted vests, rainwear, robes, rompers, rubbers, sandals, sarongs, sashes, scarves, shawls, shifts, shirts, undershirts, sweatshirts, shoes, shortalls, shorts, sweat shorts, singlets, ski suits, ski wear, skirts, slacks, sleepwear, slippers, slips, smocks, sneakers, socks, thermal socks, sport shirts, stockings, stoles, suits, snow suits, sweat suits, vested suits, warm-up suits, wet suits, sun visors, suspenders, swaddling clothes, sweaters, turtleneck sweaters, v-neck sweaters, sweatsocks, swim trunks, swim wear, swimsuits, t-shirts, tailleurs, tangas, tank tops, teddies, tennis wear, thermal underwear, thongs, ties, tights, togas, tank tops, tops, toques, tracksuits, trousers, tunics, turbans, turtlenecks, tuxedos, underclothes, undergarments, underpants, underwear, uniforms, unitards, veils, vests, visors, waistcoats, wraps, zori</p> <p>Class 041. First use:  ARRANGING AND CONDUCTING EDUCATIONAL CONFERENCES;  TELEVISION PRODUCTION, FILM PRODUCTION, PRODUCTION OF VIDEO TAPES AND VIDEO DISCS; FAN CLUB SERVICES; ENTERTAINMENT SERVICES, NAMELY ORGANIZATION, PRODUCTION AND CONDUCTING BEAUTY PAGEANTS; PROVIDING FACILITIES FOR RECREATION ACTIVITIES</p>
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U.S. Registration No.	2466852	Application Date	01/02/1998
Registration Date	07/10/2001	Foreign Priority Date	NONE
Word Mark	MR WORLD		
Design Mark	 <p><b>MR WORLD</b></p>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: entertainment services namely live shows featuring body appearance competitions and pageants; motion picture film production services; television		

	show production services and videotape production services		
U.S. Application No.	77663034	Application Date	02/04/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MISS WORLD WIDE WEB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: entertainment services, namely, conducting of beauty competitions		
U.S. Registration No.	877221	Application Date	04/05/1968
Registration Date	09/16/1969	Foreign Priority Date	NONE
Word Mark	MISS WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U107 (International Class 041). First use: First Use: 1951/07/01 First Use In Commerce: 1951/11/01 ENTERTAINMENT SERVICES-NAMELY, CONDUCTING OF BEAUTY COMPETITIONS		
Attachments	77075449#TMSN.jpeg ( 1 page )( bytes ) 78564133#TMSN.jpeg ( 1 page )( bytes ) 77367503#TMSN.jpeg ( 1 page )( bytes ) 76452884#TMSN.gif ( 1 page )( bytes ) 75412987#TMSN.gif ( 1 page )( bytes ) 77663034#TMSN.jpeg ( 1 page )( bytes ) NOO SN 77947644.PDF ( 4 pages )(127677 bytes ) 72295043#TMSN.gif ( 1 page )( bytes )		

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## **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jeffrey C. Katz/
Name	Jeffrey C. Katz
Date	09/02/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Ser. No. 77/947644 - - OG 05/10/2011

MISS WORLD LIMITED,

Opposer,

-v-

WALLY BOYKO PRODUCTIONS, INC.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Miss World Limited ("Opposer"), believes that it will be damaged by registration of the mark shown in Serial No. 77/947644, and pursuant to a previously granted extension of time, hereby opposes same on the following grounds:

1. Opposer is a public limited company organized in the United Kingdom.
2. Opposer, through its predecessors in interest, commenced use of the MISS WORLD mark in connection with its beauty pageants and competitions at least as early as November 1, 1951 and has continuously used its MISS WORLD mark since that time. Opposer has also registered and used Internet domain names in the U.S., and elsewhere, which incorporate the name "MISS WORLD" in connection with its aforesaid business activities.
3. As a result of extensive use, publicity and promotion, Opposer has developed an extremely valuable good will and reputation in the name and mark MISS WORLD, and similar names, in connection with the aforesaid services.

4. Opposer is the owner of U.S. Patent and Trademark Office (“USPTO”) Registration No. 877221 for the mark MISS WORLD registered September 16, 1969, for “entertainment services-namely, conducting of beauty competitions” in International Class 41. This registration is valid and subsisting, and is incontestable under 15 U.S.C. § 1065. A current printout of information from the electronic database records of the USPTO showing the current status and title of this registration is attached hereto. Opposer also owns similar marks, including MS. WORLD Registration Nos. 3597038 and 3587128, MR. WORLD Registration No. 3990366, as well as Registration Nos. 2915546 and 2466852, and pending Application No. 77/663034.

5. As a result of its use and ownership of the aforesaid marks, any use of a mark that involves a combination of the title or honorific such as “Ms.”, “Miss”, “Mr.” or “Mrs.”, along with “WORLD”, in connection with competitions or pageants, is likely to be associated with Opposer.

6. Opposer’s first use date of its name and mark MISS WORLD predates Applicant’s filing date for the subject mark, its claimed date of first use, or any other date upon which Applicant is permitted to rely.

7. Applicant’s mark MS. FITNESS WORLD is substantially similar to Opposer’s name and marks.

8. The services set forth in the application herein opposed are substantially similar and related to the services of Opposer.

9. In view of the foregoing, Applicant’s use of the mark MS. FITNESS WORLD in connection with the indicated services is likely to cause confusion or mistake as to



whether Applicant is in some way affiliated or otherwise connected with Opposer, or that Opposer has sponsored Applicant's services.

10. Applicant's Mark is also likely to cause dilution of the distinctive quality of Opposer's MISS WORLD mark under 15 U.S.C. § 1125(c).

11. By reason of the foregoing, the granting of a certificate of registration to Applicant would damage Opposer.

WHEREFORE, Opposer prays that said Application Serial No. 77/947644 be rejected and that registration of the mark therein shown be denied.


Please debit the amount of \$300 and any other relevant fees, from the Deposit Account No. 502293 of Opposer's counsel.

Dated: September 2, 2011

Respectfully submitted,

DAVIS & GILBERT LLP

By



Jeffrey C. Katz  
Patricia Hatry

1740 Broadway  
New York, New York 10019  
(212) 468-4800  
Attorneys for Opposer  
NY State Bar Members

CERTIFICATE OF SERVICE

THIS IS TO CERTIFY that on September 2, 2011, the foregoing Notice of Opposition was served via first-class mail upon Applicant's counsel at the following address:

John E. Halamka, Esq.  
31207 Marne Dr.  
RANCHO PALOS VERDES, CA 90275-5617

Respectfully submitted,

DAVIS & GILBERT LLP

By:

  
Jeffrey C. Katz

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Attorneys for Opposer